

REMARKS

Reconsideration of the present application in view of the following remarks is respectfully requested. The application contains claims 2, 3 and 73-109, pending and under consideration.

In the outstanding Action, claims 2, 3 and 73-116 were pending. Claims 110-116 have now been withdrawn from consideration, claims 83-84 are objected to as being dependent upon a rejected base claim, and claims 2, 3, 73-82 and 85-109 stand rejected. Reconsideration of the present application in view of the remarks set forth herein is respectfully requested. For the reasons set forth below, Applicant submits that, and respectfully requests an indication that, each of pending claims 2, 3 and 73-109 is in condition for allowance.

As an initial matter, Applicant acknowledges and thanks the Examiner for the indication in the outstanding Action that claims 83 and 84 recite allowable subject matter. The Action states that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons stated herein, Applicant submits that the base claim and the intervening claims are also in condition for allowance, and that this objection to claims 83 and 84 is therefore moot. Withdrawal of this objection is therefore respectfully requested.

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Claims 2, 3, and 73-82, 85-92 and 194-106 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grivas et al. (5,814,084) in view of Heggeness, et al. (5,514,180) and McKay (6,039,762) (hereafter the "McKay '762 patent"). It is noted that the McKay '762 patent was filed on June 11, 1997. The present application is a continuation application, and it claims priority to multiple applications in a line of cases extending back to an original parent application filed October 16, 1995. Notable for purposes of the present discussion is that the present application claims priority to Application No. 08/740,031 filed on October 23, 1996 and is therefore entitled to at least this date as its effective filing date for purposes of determining qualification of references as prior art. Since the McKay '762 patent was filed after this date, the McKay '762 patent does not qualify as prior art to the present application.

Applicants do note that the McKay '762 patent claims priority as a CIP application to U.S. Patent No. 5,702,449, filed June 7, 1995 (the "McKay '449 patent"). Applicants submit that the McKay '449 patent also fails to qualify as prior art in the present application under 35 U.S.C. § 103(c). Both the McKay '449 patent and the presently claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person. In support of this, Applicants refer to an Assignment recorded in the United States Patent and Trademark Office at Reel/Frame 8331/0839 assigning the rights in the present invention to Danek Medical, Inc. A copy of the Assignment is attached to this response as Exhibit A. Applicants also refer to an Assignment from McKay recorded in the United States Patent and Trademark Office at Reel/Frame 7598/0747 which assigned the rights in

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the McKay '449 patent to Danek Medical, Inc. A copy of this recorded assignment is attached to this Response and listed as Exhibit B.

Consequently, Applicants submit that neither the McKay '762 nor the McKay '449 patents qualify as prior art references in the present case. Accordingly, Applicants respectfully request withdraw of the rejection of claims 2, 3, 73-82, 85-92 and 94-106 under 35 U.S.C. § 103(a) as being unpatentable over Grivas in view of Heggeness and McKay.

In addition to the above, two further rejections are asserted in the outstanding Action, and each of these additional rejections also relies upon the McKay '762 patent. Specifically, claim 92 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Grivas in view of Heggeness and McKay, and further in view of Brekke; and claims 107-109 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grivas in view of Heggeness and McKay and/or, alternatively, Heggeness in view of Grivas and McKay, and further in view of Bianchi. Applicants submit that these rejections also must be withdrawn for the same reasons stated above, namely, because the McKay '762 patent does not qualify as prior art in the present case.

In view of the foregoing remarks, Applicants respectfully submit that none of the rejections asserted in the Action can be maintained. Accordingly, reconsideration leading to withdraw of all the rejections under 35 U.S.C. § 103(a) and allowance of this application containing claims 2, 3 and 73-109 are respectfully requested.

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Closing

In view of the above, Applicant respectfully submits that the rejections stated in the outstanding Action are overcome and that the present application, as amended is in condition for allowance. Action to that end is respectfully requested. If there are any remaining issues that can be addressed telephonically, the Examiner is invited to contact the undersigned to discuss the same.

Respectfully submitted,

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